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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,649	04/21/2004	Marianne Painter	12150.0011U4	4927
23850	7590	12/09/2010	EXAMINER	
Ballard Spahr LLP			BOYCE, ANDRE D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/828,649

**Applicant(s)**

PAINTER ET AL.

**Examiner**

Andre Boyce

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 21-27 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/226)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Final office action is in response to Applicant's amendment filed 10/13/10. Claims 21 and 24 have been amended, while claims 26 and 27 have been added. Claims 1-27 are pending, while claims 1-20 have been withdrawn.
2. The previously pending rejection to claims 21-25 under 35 USC § 101 has been withdrawn.
3. With respect to claim 21, Applicant's arguments filed 10/13/10 have been fully considered but they are not persuasive.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
5. Claims 21-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Steele et al (US 2002/0072975).

As per claim 21, Steele et al disclose a method for identifying a financial service provider for a business transaction (i.e., service provides automated, risk-based pricing that allows consumer to receive offers from multiple suppliers, ¶ 0005), comprising: receiving, by a computer, first selection criteria from a financial service provider (i.e., credit report from a credit bureau, ¶¶ 0036 and 0040); receiving, by the computer, qualification form data from one of a qualification form applicant and financial service provider (i.e., computer generated display for accepting consumer application input, ¶ 0056); and automatically applying, by the computer, the first selection criteria to the qualification form data to determine if any qualification form data falls within the first selection criteria (i.e., matches include a credit rating above a threshold, ¶ 0041, including a criteria of whether a credit score falls within a certain range, i.e., 700-720, ¶ 0096), providing, by the computer, qualification form data, if any, that met the first selection criteria to one or more financial service providers (i.e., if there are matches, offers are forwarded to the consumer, ¶ 0041); identifying, by the computer, qualification form data that did not meet the first selection criteria (i.e., matches based upon a credit rating above a threshold, ¶ 0041); receiving, by the computer, second selection criteria from the financial service provider, wherein the first selection criteria is more stringent than the second selection criteria (i.e., other supplier criteria, including any combination of age, home ownership, yearly income, credit rating, etc., ¶ 0041); applying, by the computer, the second selection criteria to the qualification form data that did not meet the first selection criteria to determine if any qualification form data falls within the second selection criteria (i.e.,

suppliers use preset values, tables and criteria to calculate offer terms, e.g., the criteria table may specify a credit score between 700 and 720 gets a particular offer, ¶ 0096); and providing, by the computer, qualification form data, if any, that met the second selection criteria to one or more financial service providers (i.e., modeling engine may take whatever credit score to derive a rate offer to be supplied to the consumer, ¶ 0096).

As per claim 22, Steele et al disclose receiving a credit score about the qualification form applicant from a credit agency (i.e., credit score, ¶ 0096).

As per claim 23, Steele et al disclose receiving a Fair Isaac Credit Score concerning the qualification form applicant (i.e., credit information, including a FICO score, ¶ 0168).

As per claim 24, Steele et al disclose receiving a field of information that is part of a qualification form (i.e., computer generated display for accepting consumer application input, ¶ 0056).

As per claim 25, Steele et al disclose receiving at least one of a social security number, address, phone number, e-mail address, state of residence, and income of the qualification form applicant (i.e., personal information profile 235, including name and social security number, ¶ 0035).

As per claim 26, Steele et al disclose tracking those qualification forms that did not receive a threshold number of offers from one or more financial service providers (i.e., processing used to determine what offers are sent, if any, to consumers, ¶ 0097).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steele et al (US 2002/0072975).

As per claim 27, Steele et al does not explicitly disclose wherein the second selection criteria is applied to those qualification forms that did not receive a threshold number of offers from one or more financial service providers. However, Steele et al disclose suppliers differentiating price offers based on calculated risk of a consumer meeting specified criteria, including demographic, business, employment, historical driving, etc. (¶ 0099), wherein these second set of criteria is applied to the consumer to build an overall consumer risk. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include wherein the second selection criteria is applied to those qualification forms that did not receive a threshold number of offers from one or more financial service providers in Steele et al, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

***Response to Arguments***

8. In the Remarks, Applicant argues there is no teaching in Steele of automatic application of selection criteria as presently claimed, nor is there any teaching in Steele of multiple searches to identify consumers that might not otherwise fit a stringent selection as presently claimed. Steele merely allows manual searches against a database with no teachings of targeting consumers that did not automatically match a first set of selection criteria. The Examiner respectfully disagrees. Steele et al disclose automatically applying, by the computer, the first selection criteria to the qualification form data to determine if any qualification form data falls within the first selection criteria (i.e., matches include a credit rating above a threshold, ¶ 0041, including a criteria of whether a credit score falls within a certain range, i.e., 700-720, ¶ 0096), providing, by the computer, qualification form data, if any, that met the first selection criteria to one or more financial service providers (i.e., if there are matches, offers are forwarded to the consumer, ¶ 0041); identifying, by the computer, qualification form data that did not meet the first selection criteria (i.e., matches based upon a credit rating above a threshold, ¶ 0041); receiving, by the computer, second selection criteria from the financial service provider, wherein the first selection criteria is more stringent than the second selection criteria (i.e., other supplier criteria, including any combination of age, home ownership, yearly income, credit rating, etc., ¶ 0041).

**Conclusion**

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/  
Primary Examiner, Art Unit 3623  
December 6, 2010